

## **REMARKS**

The Office Action dated March 8, 2007, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, the Specification and claims 1-3 have been amended. No new matter is presented. Claims 1-3 are pending and respectfully submitted for consideration.

### **Amendments to the Specification**

The Specification was objected to as containing new matter. The Applicant has amended the Specification to delete subject matter objected to as new matter. In view of the amendments to the Specification, the Applicant respectfully requests withdrawal of the objections to the Specification.

### **Rejections Under 35 U.S.C. § 112**

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicant has amended the claims to clarify the claimed method. The Applicant respectfully submits that all claims are in compliance with U.S. patent practice.

The Applicant respectfully submits that the above amendments place the claims in compliance with U.S. patent practice. Accordingly, the Applicant respectfully requests withdrawal of the rejection.

### **Rejection Under 35 U.S.C. § 102(b)**

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Okanishi et al. (U.S. Patent No. 5,697,359, "Okanishi"). The Applicant traverses the

rejection and respectfully submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Okanishi.

Okanishi discloses an abrasive blade with a reduced cutting noise.

Claims 1 and 2 as amended, recite a method of sawing a stone in a stone-sawing machine without generating a high-pitched noise caused by a saw blade rubbing against the stone in the stone-sawing machine. The method comprises providing grit suspended in sludge, the grit having an average grit size based on a sawing difficulty level of the stone, and providing a grit concentration in the sludge of at least 210 grams of grit per litre of sludge from the maximum size of 500, 600 or 700  $\mu\text{m}$  and 40% of the said maximum size. A noise level of the saw blade cutting through the stone is maintained at less than 80db at a distance of 1.5m from a noise measuring apparatus and thereby, the noise caused by a strip rubbing against the stone is low in pitch and free from a high-pitched noise.

With respect to claim 1, as amended, the Applicant respectfully submits that Okanishi fails to disclose or suggest the claimed features of the invention. In particular, Okanishi does not disclose or suggest at least providing grit suspended in sludge, the grit having an average size based on a sawing difficulty level of the stone, and a grit concentration in the sludge of at least 210 grams of grit from the maximum size and 40% of the maximum size. Further, claim 1, as amended, recites that a noise level of the saw blade cutting through the stone is maintained at less than 80 db at a distance of 1.5 meters from a noise measuring apparatus. In contrast, Okanishi merely discloses the lowest noise value of 89 db as shown in Table 1 and 87 db as shown in Table 2 at a distance of 1 meter from the working position.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicant respectfully submits that Okanishi does not disclose or suggest the features of the invention as recited in claim 1. Accordingly, Okanishi does not anticipate claim 1, nor is claim 1 obvious in view of Okanishi. As such, the Applicant submits that claim 1 is allowable over the cited art.

Claims 2 and 3, as amended, depend from claim 1 and are allowable for at least the same reasons.

### **Conclusion**

The Applicant respectfully submits that claim 1 is allowable. Claims 2 and 3 depend from claim 1 and incorporate the patentable aspects thereof. Accordingly, the Applicant respectfully submits that these dependent claims are also allowable. As such, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-3, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 027318-00004.**

Respectfully submitted,



Rhonda L. Barton  
Attorney for Applicant  
Registration No. 47,271

**Customer No. 004372**  
ARENT FOX LLP  
1050 Connecticut Avenue, N.W., Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000  
Fax: (202) 638-4810

RLB/elz